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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,323	03/16/2001	Daniel Keith Burns	PU3562USW	9629

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EXAMINER

JOHANNSEN, DIANA B

ART UNIT PAPER NUMBER

1634

DATE MAILED: 06/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/787,323

Applicant(s)

BURNS ET AL.

Examiner

Diana B. Johannsen

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 May 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: 7 and 9.

Claim(s) rejected: 1-11 and 14.

Claim(s) withdrawn from consideration: _____.

8. ☒ The proposed drawing correction filed on 09 May 2003 is a) ☒ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet

Continuation of 5. does NOT place the application in condition for allowance ~~because~~ for the reasons of record in view of the non-entry of the After Final amendment.

Continuation of 10. Other: The application is now in compliance with the Sequence Rules..

ATTACHMENT TO ADVISORY ACTION

New issues raised.

1. Applicant's proposed amendments raise new issues under 35 U.S.C. 102 and/or 103 that would require further search and consideration. Particularly, regarding claims 1-5, applicant has proposed broadening the claims such that they are no longer limited to methods in which products are loaded onto a gel (but rather encompass the use of any type of "an electrophoresis sequencing device"). Accordingly, the proposed amendments would necessitate a new search and consideration of whether such methods are anticipated and/or obvious. Regarding claims 6-11, applicant has proposed broadening the claims such that they are no longer limited to methods in which "electrophoresis analysis" of reaction products is performed, but in which any method step that accomplishes "determining the sequence" may be carried out. Accordingly, the proposed amendments would necessitate a new search and consideration of whether such methods are anticipated and/or obvious.
2. Applicant's proposed amendments raise new issues under 35 U.S.C. 112, second paragraph, that would require further consideration. Regarding claims 1-5, applicant has proposed amending independent claim 1 such that it recites "determining the sequence of the first short sequencing reaction product and the sequence of the second short sequencing reaction product." It is unclear as to whether the claims as amended are drawn to methods of "determining the sequence" of first and second sequencing reaction products, or to methods of "identifying a nucleotide sequence of a nucleic acid," as recited in the claim preamble. Regarding claim 14, applicant has

proposed amending the claim to recite "an amplified fragment" in lieu of "the amplified fragment." However, the recitation "an amplified fragment" is also unclear, as it is unknown as to what previously recited molecules would be considered to constituted "amplified fragments" (e.g., does this recitation refer to products of nucleic acid amplification, to products of digestion, to either, etc.?).

Information Disclosure Statement

3. Regarding the information disclosure statement filed November 9, 2001, it is again noted that legible copies of document numbers 3-8 have not been provided. While applicant indicated in the Remarks of May 9, 2003 that legible copies of the documents had been submitted, legible copies have not actually been received. Accordingly, the documents have not been considered.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diana B. Johannsen whose telephone number is 703/305-0761. The examiner can normally be reached on Monday-Friday, 7:30 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached at 703/308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are 703/872-9306 for regular communications and 703/872-9307 for After Final communications.

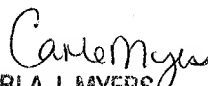
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/308-0196.

Diana B. Johannsen
June 2, 2003


CARLA J. MYERS
PRIMARY EXAMINER